

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 March 2008 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "The advertiser" (e.g., at claim 1 lines 5 and 6), "the advertiser Web site" and "content from the advertiser" are indefinite.
4. The claimed limitation to "the advertiser" is interpreted to be based on ownership. Ownership is inherently indefinite because it is not concrete (predictable). The US Supreme Court has ruled that "A corporation is an artificial being, invisible, intangible and existing only in contemplation of law." *CTS Corp. v. Dynamics Corp. of America*, 481 U.S. 69, 89, 107 S. Ct. 1637, 1649-1650 (1987) (citing *Trustees of Dartmouth College v. Woodward*, 17 U.S. (4 Wheat) 518 (1819)). A business entity can be created, merged, dispersed or destroyed at human whim. Hence, in accordance with the *State Street* decision (MPEP 2106.II.A), ownership language cannot impart patentability.
5. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and

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bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.

6. The instant application contains no such clear definitions for the phrases "Web site" or "advertiser web site". Both are supported by numerous example uses (e.g., at para. [0027] of the published application, US 20020082923A1), but that does not meet the requirements for a "clear definition." In the instant case, the examiner is required to give the term "Web site" its broadest reasonable interpretation, which the examiner judges to be an image or group of documents accessible on the World Wide Web network. At its broadest, a Web site would embody and be characterized by its network address. Said website address is property and could therefore be bought and sold. "The advertiser Web site" is interpreted as a certain website address owned by "the advertiser". "The advertiser", as a legal person, may own other assets such as certain products characterized by their trademarks.
7. Assume a patent was granted with claims limited to "content from the advertiser" being displayed on "the advertiser Web site". "The advertiser" practices the invention. What would happen if "the advertiser" sold the underlying product and all associated ad content? Would the patent still be valid if the content, which is no longer "content from the (original) advertiser", continued to be displayed on the same web site? Who is "the advertiser": the former or the present owner of "content from the advertiser"? Alternatively, what would happen if "the advertiser" sold "the advertiser web site" but kept the product and "content from the advertiser"? Would the patent still be applicable if the "content from the advertiser" continued to be displayed on the same web site, which is no longer "the (original) advertiser Web site"? Alternatively, assume "N" companies buy shares in "the advertiser": Are all "N" owners now "the advertiser", so the patent is applicable whenever any of the "N", but no one else, displays content on "the advertiser Web site"? If so, and the "N" companies are publicly traded, applicability of the patent could change moment to moment as shares were traded and any one or more of the "N" companies became or ceased to be owners of "the (original) advertiser". "The advertiser" is not a tenable claim limitation because "the advertiser" inherently lacks the predictability required by the State Street decision.

Claim Rejections - 35 USC § 102 and 35 USC § 103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 5-11, 18-20, 23-29, 36-38, 41-47, 54 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Roth et al. (US006285987B1).

11. Roth et al. teaches (independent claims 1, 19, 37 and 55) a method, system and computer readable medium for online re-targeted advertisement selection, the method comprising:

- (a) receiving feedback on prior activities of a user at a Web site (col. 4 lines 44-49);
- (b) receiving a request to display advertising content to the user (col. 4 lines 58-61); and
- (c) selecting, in response to the request, advertising content for display based upon the received feedback on prior activities of the user at the Web site (col. 2 lines 11-31 and 31-37).

12. The claim language “a/the advertiser” is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01). In the sense used in the patent law (35 USC 101), “the advertiser” is not functional because it is neither “tied to a particular apparatus” nor “operates to change materials to ‘a different state or thing’” (*IN RE COMISKEY*, CAFC 2006-1286, September 2007).

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13. Roth et al. teaches at the citations given above claims 7, 25 and 43.
14. “Re-targeted”: The term is used only in the preamble of each independent claim, but it is a limitation in the body of dependent claims 11-17, 29-35 and 47-53. The published application (para. [0030]) clearly defines a “re-targeted ad” as an ad that is “history specific to the present user”. That is, a “re-targeted” ad is an ad whose selection is based on “the past response(s) of the present viewer”. Roth et al. teaches “re-targeted” ads as the advertising content (para. 11 above).
15. Roth et al. teaches: claims 2, 20 and 38 (col. 5 lines 24-27); claims 5, 23 and 41 (col. 5 lines 20-23, where a *HTML reference* reads on “a tag”); claims 6, 24 and 42 (col. 19 lines 24-33, where *ISP 712* reads on “a proxy server”); claims 8, 26 and 44 (col. 8 lines 65-67); claims 9, 27 and 45 (col. 18 lines 46-48); claims 10, 11, 28, 29, 46 and 47 (col. 7 lines 34-38 and Fig. 3, elements 16A and 16B, and Fig. 4); and claims 18, 36 and 54 (front page, “article by Toland”).
16. Claims 3, 4, 12-17, 21, 22, 30-35, 39-40, and 48-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. (US006285987B1).
17. Roth et al. does not teach that: feedback is received by email or FTP message (claims 2, 4, 21, 22, 39 and 40); the re-targeted ad is a coupon when the user visited the web site but did not purchase the product (claims 12, 13, 30, 31, 48 and 49); the re-targeted ad is a reminder when the user made previous but not recent purchases (claims 14, 15, 32, 33, 50 and 51); and the re-targeted ad is best-customer thank you when the user made purchases at some minimum rate (claims 16, 17, 34, 35, 52 and 53). Roth et al. does teach acquiring data on frequency of site visit and purchases (col. 2 lines 37-41, col. 4 lines 11-15, col. 4 line 63 to col. 5 line 5 line 8, col. 8 lines 53-55 and 65-67, and col. 9 lines 57-58).
18. Official notice of this common knowledge or fact well known in the art was taken in the Office action mailed 6 April 2007 (para. 8). Since applicant failed to traverse the examiner’s assertion, it is taken to be admitted prior art (MPEP 2144.03.C).
19. In addition, Roth et al. does not teach that the tag is a graphic (claims 56-58). Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to for hyperlinks, which reads on a tag, to be marked with a graphic (an image).

Response to Arguments

20. Applicant's arguments filed with an amendment on 14 March 2008 have been fully considered but they are not persuasive. The arguments have been addressed by the revised rejection presented above.

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
22. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
24. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.